REMARKS

Applicant wishes to thank the Examiner for examining the application and for the courtesy extended in granting a telephone interview with Applicant's agents, John R.S. Orange and Sean X. Zhang, conducted on July 7, 2010.

This Office Action was issued as a reply to Applicant's submission of May 17, 2010 filed in response to a final Office Action mailed on March 9, 2010. In this Office Action, the Examiner withdrew the 35 USC § 101 rejection of claims 14 and 24 and the finality of the Office Action of March 9, 2010, which Applicant acknowledges.

Currently, claims 14-56 are pending and all pending claims still stand rejected under 35 USC § 103(a). The Action is also made final.

Claim rejections under 35 USC § 103(a) were discussed during the telephone interview. During the interview, both the Examiner's interpretation and Applicant's interpretation of the claim language and the prior art, in particular, Gross, were discussed. No agreement was reached.

Claim Rejections – 35 USC §103

(a) Claims 14-17, 20-43, and 47-56

The Examiner rejected claims 14-17, 20-43 and 47-56 under 35 USC §103(a) as being obvious over Schiavone (U.S. Patent Application Publication No. 2002/0120600), in view of Gross (U.S. Patent Application Publication No. 2004/0111478).

Claims 14, 24, 37, 47 and 52 are independent claims. Claims 15-17 and 20-23 depend from claim 14. Claims 25-36 depend from claim 24. Claims 38-43 depend from claim 37. Claims 48-51 depend from claim 47. Claims 53-56 depend from claim 52. Independent claims 14, 24, 37, 47 and 52 will be first considered below.

Claims 14, 24, 37, 47 and 52, as amended in a claim amendment submitted on June 9, 2009, all require that the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories. These independent claims also all require that the negotiation of a category between the sender subsystem and the receiver subsystem to be initiated by the sender subsystem and that the negotiated category is to be associated with an outgoing message. For example, both claims 14 and 24 require, among

others, the sender subsystem to initiate a categorization negotiation process with the receiver subsystem and to associate the negotiated category with the message. Similar claim limitations, with varying level of detail, are also required by other independent claims.

As previously submitted, the combined teachings in Schiavone and Gross does not in fact teach a system or method that meets all claim limitations as recited in these independent claims, despite the Examiner's assertions.

For example, claim 14 recites a system that includes a sender subsystem and a receiver subsystem, wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to the listing of receiver categories. The Examiner alleged that Gross taught this feature and cited paragraph [00263] in Gross to support this position. According to the Examiner,

"wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories [*See* Response to Arguments, section C, above | Gross, Fig. 1: sender and receiver using a personal computer and system where the personal computer/system read on Applicant's claimed subsystem | 0263: sender making suggestions through his computer to the receiver]" (page 5, Office Action),

and further,

"it is clear from Gross that while a human operator adds the category, he does so using the subsystem. In other words, the subsystem carries out the operator's command." (Response to Arguments, section C on page 3, Office Action),

and further,

"if a reference teaches that human operator uses a subsystem to add a new category, then that reference would meet the language of the claim because a subsystem carries out the human's command to add the category." (Response to Arguments, section C on page 3, Office Action)

For easy reference, paragraph [0263] from Gross is reproduced below in its entirety:

> It will be appreciated that new processing criteria can be continuously added, deleted, or changed by a recipient or a 3rd party, such as an administrator, on behalf of the recipient. It will also be appreciated that a sender can make suggestions to a receiver--by, for example, means of a message--to add processing criteria not yet known to the receiver, which the

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receiver can confirm to accept or reject. (Emphasis added)

As already submitted in the response filed on June 9, 2010, it is clear that Gross does not in fact, in this paragraph (and elsewhere), disclose any receiver subsystem and sender subsystem, wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to the listing of receiver categories. As also recognized by the Examiner, it is a human receiver (not a receiver subsystem) who uses a subsystem ("he does so using the subsystem", page 5, Office Action) to accept or reject a suggestion from another human sender.

Applicant respectfully disagrees with the Examiner's assertion that "if a reference teaches that human operator uses a subsystem to add a new category, then that reference would meet the language of the claim because a subsystem carries out the human's command to add the category". There might be a system, i.e., "the personal computer/system" of Gross, as identified by the Examiner, which a user could use to do certain things. However, there is no teaching, at least in this cited paragraph, that the receiver subsystem is configured in a particular way as required by Applicant's claims, i.e., to permit the sender subsystem to add a new category. There is simply no such disclosure, as can be seen in paragraph [0263] quoted above. In addition, even if Gross's user using a personal computer to add a category could be implied, a user using a system to carry out certain functions is different from a subsystem being configured to permit another subsystem to perform the functions. The short paragraph in Gross simply does not teach what is recited in Applicant's claims.

During the telephone interview, the Examiner explained that Gross teaches a human receiver interacting with a human sender. Therefore, implicitly, the computer and the e-mail system of human receiver, together with the human receiver, may be considered a receiver subsystem and the computer and the e-mail system of human sender, together with the human sender, may be considered a sender subsystem. As a human operator could add a category as suggested by another human operator, the subsystem including a human operator could be considered as a subsystem that is configured to add a new category. Such a receiver subsystem and such a sender subsystem would read on Applicant's claim limitations.

Applicant respectfully disagrees that Applicant's claims or the prior art may be so broadly interpreted. An Office personnel must interpret the prior art references and claims under examination "reasonably" (MPEP 2111). A reasonable interpretation is not one without any bound. "The broadest reasonable interpretation of the claims must also be consistent with the

interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)" (MPEP 2111). If the Examiner's interpretation were accepted, such an interpretation would include a human operator in the recited subsystem. This is not consistent with Applicant's claims nor an interpretation of any person skilled in the art. For example, claim 14 is directed to an "e-mail system for exchanging messages among users of the system". Clearly, users are not part of the system. This is also clear from the disclosure. For example, Fig. 9 shows a system used by a user to negotiate and add a new category and reflects a possible user's view of the interaction with the system. Clearly, "system" as used in Applicant's claims or disclosure could not possibly include a human operator. Applicant also notes that any claim that recites a human being as part of the claim element could hardly be statutory subject matter. Therefore, it is respectfully submitted that a subsystem as recited in Applicant's claims could not possibly include a human operator if interpreted reasonably.

Further, even according to the Examiner's own broad interpretation, Gross's teaching still would not meet the claim limitation of Applicant's claims. This was discussed during the telephone interview and also noted in the submission filed on June 9, 2009. This is also further discussed below.

As submitted in a response filed on June 9, 2009, Gross only discloses that a "sender" may suggest a new category. The acceptance or rejection of the sender's suggestion must be confirmed by the receiver. Accepting or rejecting a category, let alone adding a new category, always requires the action of the receiver. Adding a new process criteria, according to Gross, would be done by the recipient or an administrator on behalf of the recipient. What is described in Gross is simply the opposite of what is required by Applicant's claims: Gross describes a scenario that always requires the action of the receiver; whereas according to Applicant's claims, adding a new category by the sender subsystem is always permitted by the receiver subsystem (the receiver subsystem is configured to permit the sender subsystem to add a new category to the listing of receiver categories). Gross describes that the recipient does not permit the sender to add anything; it does not describe a receiver subsystem that is configured to permit the sender subsystem to add a new category.

Accordingly, even according to the Examiner's own interpretation, Gross still does not disclose at least the claim limitation "the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories." Thus, the combined teaching of Schiavone and Gross still would be different from Applicant's claims. For this reason alone, it is respectfully submitted that none of independent claims 14, 24, 37, 47 and 52

would have been obvious in view of Schiavone and Gross.

During the telephone interview, the Examiner indicated that he would need to consult Gross again to evaluate this argument but agreed that this particular argument would not raise any new issue as long as no claim amendment is made. Should the Examine, having reviewed Gross again, find this argument not persuasive, Applicant wishes to have another opportunity to discuss with the Examiner, in the presence of his supervisor, the Examiner's rational as to how Gross would teach the claim limitation before the next action is issued.

In citing paragraph [0263] of Gross as teaching adding a new category, the Examiner also took the position that the process criteria referenced in paragraph [00263] could be treated as categories. Applicant respectfully disagrees. As previously submitted, adding new process criteria merely tells the system additional ways to process a message. Adding a new process criteria is not the same as adding a new category. To understand what is meant by "process criteria", one looks at Gross's own teaching. According to Gross, "the message is processed in accordance with processes identified by the tags" (para. [0044], Gross), and "[t]hese processing criteria are unique tags associated with the processing criteria" (para. [0042], Gross). A categorized message may be processed in a certain way as directed by a particular processing tag. However, processing a message is a process different from associating a new category with a message, which could be processed in a certain way. Accordingly, there is also no teaching in paragraph [0263] of Gross that a new category is accepted or rejected (see, for example, p. 16 of the response filed on June 9, 2009 and p. 15-16 of response filed on September 29, 2008).

In addition, as also submitted and discussed more fully in the previous responses, the combined teaching in Schiavone and Gross also does not in fact teach a process to negotiate a category that is initiated by the sender subsystem, and a sender subsystem associating a negotiated category with a message. Thus, because of these additional differences, the combined teaching in Schiavone and Gross also could not render the subject matter of any of these independent claims obvious.

Further, as previously submitted, Schiavone and Gross may not be properly combined. Simply because some prior art teachings could be combined does not necessarily render the claimed subject matter obvious. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP, 2143.01 V. Accordingly, it is respectfully submitted

that, even if the combined teaching of Schiavone and Gross would teach all claim limitations, Schiavone and Gross still would not render Applicant's claims obvious as these two references may not be properly combined.

The Examiner attempted to combine the teaching of Schiavone with that of Gross to produce the claimed subject matter. However, Gross teaches that it is for the receiver to accept or reject any suggestion from the sender, whereas Applicant's claims require that the sender and receiver subsystems are such that the sender subsystem is always permitted to add a new category. The receiver subsystem is already configured to permit the sender subsystem to perform this act. It is clear that Gross emphasizes on control by the receiver ("Upon receipt of a tagged message, the message is processed in accordance with processes identifies by the tags. The recipient maintains control of the processing of the messages," para. [0044], Gross). This is the opposite of how Applicant's claimed system functions. Modifying Gross' system to give control to the sender subsystem would be against the objective of Gross' invention. Accordingly, the combination of teaching of Schiavone with that of Gross suggested by the Examiner is not proper.

For this additional reason alone, it is respectfully submitted that claim 14 would not be obvious in view of Schiavone and Gross. Similarly, other independent claims, namely claims 24, 37, 47 and 52, all require such a sender subsystem and such a receiver subsystem as required by claim 14. It is respectfully submitted that at least for the additional reason that the teachings in Schiavone and Gross cannot be properly combined, the subject matter of any of claims 24, 37, 47 and 52 also would not have been obvious in view of Schiavone and Gross.

For any of the reasons discussed above, it is respectfully submitted that the subject matter of any of independent claims 14, 24, 37, 47 and 52 would not have been obvious in view of Schiavone and Gross. The withdrawal of rejections of claims 14, 24, 37, 47 and 52 is respectfully requested.

In addition, inasmuch as claims 15-17and 20-23 depend from claim 14 and incorporate by reference all claim limitations of claim 14, claims 25-36 depend from claim 24 and incorporate by reference all claim limitations of claim 24, claims 38-43 depend from claim 37 and incorporate by reference all claim limitations of claim 37, claims 48-51 depend from claim 47 and incorporate by reference all claim limitations of claim 47, and claims 53-56 depend from claim 52 and incorporate by reference all claim limitations of claim 52, it is respectfully submitted that none of these dependent claims would have been obvious in view of Schiavone and Gross.

The withdrawal of rejections of claims 15-17, 20-23, 25-36, 38-43, 48-51, and 53-56 is also respectfully requested.

(b) Claims 18, 19, and 44-46

The Examiner rejected claims 18, 19 and 44-46 under 35 USC §103(a) as being obvious over Schiavone and Gross, in view of Koenig (U.S. Patent Application Publication No. 2002/0120748).

As discussed above in connection with claim 14, Schiavone and Gross, either alone or in combination, do not teach each and every claim limitations of claim 14. This is not cured by Koenig. Therefore, Schiavone, Gross and Koenig, even in combination, also do not teach each and every claim limitations of claim 14.

Claims 18 and 19 depend from claim 14 and incorporate by reference all claim limitations of claim 14. For at least the same reasons discussed above in connection with claim 14, it is respectfully submitted that the Examiner's conclusion of obviousness cannot be supported by the cited references, namely Schiavone, Gross and Koenig, and that a prima facie case of obviousness has not been established. The withdrawal of rejection of claims 18 and 19 is respectfully requested.

Claims 44-46 depend from claim 37 and incorporate by reference all claim limitations of claim 37. As discussed above in connection with claim 37, Schiavone and Gross, either alone or in combination, do not teach each and every claim limitations of claim 37. This is not cured by Koenig. Therefore, Schiavone, Gross and Koenig, even in combination, also do not teach each and every claim limitations of claim 37.
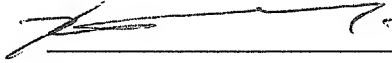
For at least the same reasons discussed above in connection with claim 37, it is respectfully submitted that the Examiner's conclusion of obviousness cannot be supported by the cited references, namely Schiavone, Gross and Koenig. The withdrawal of rejection of claims 44-46 is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 14 to 56, as presented, are all novel, non-obvious and are all allowable over the references cited. Applicant respectfully requests the reconsideration of the rejections of all pending claims and allowance of the present application.

If the Examiner believes that a telephone interview would help expedite the prosecution of the application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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